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EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/653,384	Applicant(s) SHOLEM, STEVEN L.	
	Examiner Carolyn M. Bleck	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39,42-51 and 53-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39, 42-51, and 53-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 19 September 2005. Claims 39, 42-51, and 53-61 are pending. Claim 39 has been amended. Claim 52 has been cancelled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 39, 42-51, and 53-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 39 has been amended to recite "generates an indication of when a patient's appointment should be scheduled, depending in part upon the net present value." At page 35 of Applicant's specification, Applicant describes that the software generates an indicator of relative value of the services in accordance with the calculated relative value and provides the medical services provider staff member with an indication (e.g., red, orange, or green indicator symbols) of whether it would be profitable for this medical services provider to accept this new patient." In Figure 6,

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Applicant shows at numbers 144, 146, 148, and 150 that a green indicator is for services that will likely be profitable, an orange indicator is for services that are likely to at least break even, and a red indicator is for services that will likely not be profitable.

The specification does not describe the step of generating an indication of when a patient's appointment should be scheduled, depending in part upon the net present value to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It appears that the software system generates an indication of whether a patient will be profitable or not, which is based on a likelihood that the TPP will pay. The specification does not describe how the information on whether a patient will be profitable or information on the likelihood a TPP will pay leads to a determination of "when a patient should be scheduled."

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 39, 42-51, and 53-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 39 recites "a system" in the preamble, and then recites "a processor operating in accordance with software, wherein the processor, under software control" receives an identifier..., accesses data..., generates an indication of the NPV..., and generates an indication. Claim 39 recites both a system and the method for using the system. A claim reciting an apparatus and a method of using that apparatus renders the claim indefinite because it

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does not apprise a person of ordinary skill in the art of its scope, and thus is invalid under 35 U.S.C. § 112, paragraph 2. See *IPXL Holdings, L.L.C. v. Amazon.com, Inc.* (CAFC, 05-1009, -1487, 11/21/2005).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 39, 42-51, 53, and 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keyes et al. (6,456,983) in view of Jones (6,044,351) and Evans (5,924,074).

(A) As per claim 39, Keyes discloses a method for evaluating an offer which has been made in relation to certain delinquent accounts comprising:

(a) a desktop computer with a computer readable storage medium, wherein the computer outputs data (Fig. 6, col. 4 lines 42-67), wherein the computer is configured to:

1) receive an offer associated with a current account (Fig. 5, col. 8 lines 7-38);

2) evaluate the offer by retrieving an appropriate collection of historical data based upon analysis of the historical data, identifying basis for dividing the

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retrieved collection of historical data into a plurality of groups, obtaining information on the payment history of each of these groups, processing this information and making a recommendation on the disposition of the account (Abstract; col. 4 line 42 to col. 5 line 10); and

3) calculating the net present value of each portion of the portfolio based on the historical information (Abstract; col. 9 line 38 to col. 10 line 19).

Keyes fails to expressly disclose a system related to the health care environment.

Jones discloses a system for predicting the probability distribution of a health care facility's predicted future minimum income for a total time interval (Abstract; col. 13 line 45 to col. 14 line 36).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Jones within the system of Keyes with the motivation of allowing a physician to predict future health care income to plan for the "worst care" scenario (Jones; col. 1 lines 10-20).

Keyes and Jones fail to expressly disclose software configured to generate an indication of when a patient's appointment should be scheduled.

Evans discloses enabling a healthcare provider to schedule a patient appointment using a point and click interface by selecting an appointment data and an appointment time, and wherein the healthcare provider can review prior or future scheduled appointments by clicking on an appointment button (Figure 2, col. 5 line 29 to col. 6 line 9).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Keyes and Jones with the motivation of quickly and efficiently capturing patient data (Evans; col. 2 lines 20-45).

(B) As per claim 42, Keyes and Jones fail to expressly disclose a time delay in payment of fees by the TPP, an allowable fee schedule of the TPP, or a percentage of the allowable fees paid by the TPP. However, it is respectfully submitted that typically health care providers and insurance companies have data stored in a database regarding the percentage of allowable fees paid by the insurer and the providers also store data on when a provider is paid by the insurance company. The skilled artisan would have found it an obvious modification to the system of Keyes and Jones to include this data with the motivation of valuing a particular procedure, good, or service, thus ensuring profitability for the health care provider.

(C) As per claim 43, Keyes discloses each current portfolio group 96 has: 1) a NPV-Sell identifier 74 associated therewith which is representative of a monetary amount which would be paid to an issuer of the delinquent accounts, and is derived for each current portfolio group 96 by multiplying its corresponding total balance identifier 34 by a predetermined percentage, which is the offer in this case (6% in the subject example); 2) a NPV-Agency identifier 82 which is the "result" of action 66 of the evaluation subroutine 72 of FIG. 5 (knowing the relevant liquidation profile 42 of the

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corresponding historical portfolio group 91, and knowing the outstanding balance identifier 34 of the subject current portfolio group 96, and making certain assumptions, a projected value 106 (e.g., an average to be associated with each current delinquent account 94 within the subject current portfolio group 96) may be derived); and 3) a NPV-Internal identifier 78 which is projection of a net present value if internal collections were used in relation to the subject current delinquent accounts 94. Various ways could be implemented for determining the NPV-Internal identifier 78. For instance, such could be determined in the same manner as the NPV-Agency identifier 82 through development of appropriate liquidation profiles. Moreover, the NPV-Internal identifiers 78 could be derived by assuming a particular collection percentage, as well as taking into account the cost associated with such collections.

(D) As per claim 44, Keyes and Jones fail to expressly disclose the cost of providing at least one medical service being a function of at least one of administrative cost of a medical services provider, an overhead cost of a medical office, a cost for medical office staff salaries, an equipment and supplies cost, and a utilities cost.

However, it is well known that in a business, setting the cost of a product or service would include within the cost calculation, calculating the administrative cost, overhead costs, and costs of staff, equipment, supplies, and utilities.

At the time the invention was made, it would have been obvious to modify the system of Keyes and Jones by using the cost calculation with the motivation of properly

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valuing the particular procedure, good, or service, thus ensuring profitability for the health care provider.

(E) As per claim 45, Keyes discloses a plurality of ranked indicators (Fig. 3 and 4).

(F) As per claim 46, Keyes and Jones do not disclose presenting color coded indicators of the NPV. The Examiner respectfully submits that presenting indicators in a user interface using colors is a well known technique in the graphical user interface arts. The motivation being to allow a user to quickly ascertain information.

(G) As per claim 47, Keyes discloses the an account being associated with a person and software giving an indication of whether the account is profitable to accept (col. 3 lines 23-54).

(H) Claims 48-51 and 53 repeat the limitations of claims 39 and 45, and is therefore rejected for the same reason as claims 39 and 45, and incorporated herein.

(I) As per claim 59, Keyes and Jones fail to expressly disclose at least one electronic device being configured as one of a wireless access terminal and a wireless interface, and the at least one electronic device further comprising software configured to transmit to a pharmacy a prescription, billing information, and an address to which the prescription should be delivered.

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Evans discloses communicating using a pen computer through a wireless transceiver (Figure 24, col. 12 line 55 to col. 13 line 56), wherein the pen computer is able to transmit a physician's prescription for medication to a hospital or pharmacy (col. 10 line 59 to col. 11 line 8).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Keyes and Jones with the motivation of allowing a remotely located healthcare provider to communicate information to a pharmacy (Evans; col. 1 line 53 to col. 2 line 20).

As per the recitation of "billing information and an address to which the prescription should be delivered", it is respectfully submitted that any pharmacy would require billing information, for example a patient's insurance information, and the patient's address to be included in a prescription submitted by a physician.

(J) As per claim 60, Keyes and Jones fail to expressly disclose software configured to evaluate a use pattern of at least one supply of a medical services provider, evaluate an inventory quantity of at least one supply, evaluate an estimated scheduled appointment use of the at least one supply, and automatically order an appropriate quantity of the at least one supply.

Evans discloses an electronic medical records system providing the capability to analyze utilization of physicians, nurses, staff, and equipment as well as time utilization for patients, such as wait times for referrals, lab results, and physician's examinations (col. 14 line 42 to col. 15 line 7).

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At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Keyes and Jones with the motivation of allowing a physician to have a complete audit trail of resources used in real-time (Evans; col. 2 lines 20-65).

(K) As per claim 61, Keyes and Jones do not expressly disclose a biometric identifying device.

However, it is well known in the art to use biometric identifying devices. At the time the invention was made, it would have been obvious to modify the system of Keyes and Jones with a biometric device with the motivation of providing a security mechanism to ensure the privacy of patient data.

8. Claims 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keyes et al. (6,456,983) in view of Jones (6,044,351) and Evans (5,924,074), as applied to claim 39, and further in view of Rensimer et al. (5,845,253).

(A) As per claim 54, the teachings of Keyes and Jones disclosed in the rejection above are incorporated herein.

Keyes and Jones fail to expressly disclose generating a recommended duration for a primary medical personnel to visit the patient.

Rensimer discloses using a CPT clinical status code used by a health care provider, wherein the CPT code has an associated standard amount of time for a provider to interact with a patient (col. 4 lines 24-33).

At the time the invention was made, it would have been obvious to combine the features of Rensimer within the system of Keyes and Jones with the motivation of allowing a physician to better understand the allocation of professional resources used in a given practice during a particular period of time (Rensimer; col. 1 line 63 to col. 2 line 21).

(B) As per claim 55, Keyes, Jones, and Rensimer do not expressly disclose generating a timer indicating time remaining in the recommended duration.

However, as discussed above, Rensimer discloses using a CPT clinical status code used by a health care provider, wherein the CPT code has an associated standard amount of time for a provider to interact with a patient (col. 4 lines 24-33). It is respectfully submitted that generating a timer is a well known technique used for measuring time. The motivation being to ensure a physician is able to keep within the allocated time for an appointment of a patient.

9. Claims 56-58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keyes et al. (6,456,983) in view of Jones (6,044,351) and Evans (5,924,074) as applied to claim 39, and further in view of Joao (6,283,761).

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(A) As per claim 58, the teachings of Keyes and Jones disclosed in the rejection above are incorporated herein.

Keyes and Jones fail to expressly disclose at least one electronic device configured as one of a wireless access terminal and a wireless interface, and the at least one electronic device further comprising software configured to receive an electronic superbill and automatically send related charges to a third party provider for payment.

Joao discloses a central processing computer, provider computer, and payer computer being capable of transmitting information over a wireless communication network or system (col. 14 line 48 to col. 15 line 58), wherein the provider computer generates a claim form for submission to at least one of a healthcare payer and a healthcare insurer (col. 43 lines 30-55).

At the time the invention was made, it would have been obvious to combine the features of Joao within the system of Keyes and Jones with the motivation of reducing the costs of processing treatment claims and/or claims for healthcare services and/or benefits by performing claims processing electronically (Joao; col. 2 lines 1-12).

In addition, as per the recitation of an "electronic superbill", it is noted that Joao's recitation of a "claim form" is considered to be a form of an "electronic superbill". Further, it is noted that a "superbill" is a commonly used method of recording patient care information in a form.

Response to Arguments

10. Applicant's arguments filed 19 September 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 19 September 2005.

(A) At pages 8-10 of the response filed 19 September 2005, Applicant argues that there is no motivation or suggestion to combine the references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has provided a motivation which is based on the teachings of the applied prior art (with the motivation of allowing a physician to predict future health care income to plan for the "worst care" scenario (Jones; col. 1 lines 10-20)).

In response to applicant's argument that the references do not indicate how Keyes and Jones should be combined, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*,

642 F.2d 413, 208 USPQ 871 (CCPA 1981). The Examiner relied on the Keyes reference for teaching the steps recited in claim 39. However, Keyes did not disclose the reference being in a healthcare environment. Thus, the Examiner relied upon Jones for the teachings of a healthcare environment. The Keyes reference discloses that “variations and modifications commensurate with the above teachings, and skill and knowledge of the relevant art, are within the scope of this disclosure.” Thus, the Examiner respectfully submits that the reference suggests to one of ordinary skill in the art, that the Keyes reference could be modified to be used in another environment (i.e., healthcare) and that the combination of Keyes and Jones would have been obvious to one of ordinary skill in the art.

In addition, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 19 September 2005 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Keyes, Jones, and/or Evans, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. Any response to this action should be mailed to:


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(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB
January 14, 2006


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER